In the second restriction requirement, the Examiner maintains that the subject application should be restricted to one of the alleged four "inventions" of Groups 1 through 4. Responding thereto, Applicants hereby elect, with traverse, the Group 1 invention presently defined SEQ ID No. 1 which represents the nucleic acid sequence of CKLF1. Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

In the third restriction requirement, the Examiner maintains that the subject application should be restricted to one of the alleged four "inventions" of Groups 5 through 8. Responding thereto, Applicants hereby elect, with traverse, the Group 5 invention presently defined SEQ ID No. 2 which represents the amino acid sequence of CKLF1. Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

REMARKS

The Examiner is respectfully requested to reconsider the restriction requirement under 35 USC §121 to elect a single invention. The requirements of §121 are that the inventions be independent and distinct. Both requirements are necessary to maintain a restriction requirement. Applicants respectfully maintain that the Examiner has not focused upon the two requirements of being independent and distinct. It is noted that M.P.E.P. §802.01 provides a definition of independent as follows:

> The term "independent" [i.e., not dependent] means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, [1] species under a genus which species are not usable together as disclosed or [2] process and apparatus incapable of being used in practicing the process.

Applicants contend that in Restriction 1, Groups A-B might present distinct inventions but each is not independent of the other. More specifically, A-B relate to

polynucleotides encoding the chemokine-like factor (CKLF) polypeptides and the produced CKLF polypeptides. It is apparent to one skilled in the art that the structures of the CKLF polypeptides (SEQ ID Nos. 2, 4, 6 and 8) of Group B directly depend on the polynucleotides (SEQ ID Nos. 1, 3, 5 and 7) of Group A. Therefore, Group A and Group B are not independent of each other. Moreover, Applicants further contend that in Restriction 2, Groups 1-4 and in Restriction 3, Groups 5-8 are also not independent from each other. More particularly, the polypeptides (SEQ ID Nos. 2, 4, 6 and 8) have a similarity of structure and a community of properties of chemokine-like factors (CKLFs) with chemotactic and hematopoietic stimulating activities, and the polynucleotide SEQ ID Nos: 1, 3, 5, and 7 encode these similar and related polypeptides.

More specifically, in the second and third restriction requirements, the Examiner asserts that the only common feature of the recited SEQ ID Nos: 1, 3, 5, and 7 and SEQ ID Nos: 2, 4, 6, and 8 is a general secondary structure resemblance. Applicants respectfully disagree. In the Specification as filed, Applicants specifically disclosed that SEQ ID Nos: 2, 4, 6, and 8 share partial common sequence, as shown by the amino acid sequences. Furthermore, the instant Specification disclosed that there is no frame shift mutation in the nucleic acid sequences of SEQ ID Nos: 3, 5 and 7 compared with that of SEQ ID No: 1, wherein SEQ ID Nos: 3, 5 and 7 encode the CKLF2, CKLF3 and CKLF4 polypeptides (page 6, lines 17-26 of the Specification as filed). The CKLF2, CKLF3 and CKLF4 polypeptides are probably allelic gene variants of the CKLF1 polypeptide. Therefore, based on the structural and functional similarity of this group of polypeptides Applicants believe that the SEQ ID Nos: 2, 4, 6, and 8 should not be restricted in separate inventions. Furthermore, the polynucleotides SEQ ID Nos: 1, 3, 5, and 7, which encode the related polypeptides, should not be restricted in separate inventions.

Applicants refer to M.P.E.P. §808.1 for further guidance in determining whether the Groups are independent. Therein, it states that the facts relied upon to demonstrate that the Group inventions are independent are in essence the reasons for insisting upon restriction, and that this situation, is but rarely presented.

Applicants note the Examiner is requiring Applicants to choose a nucleic acid sequence of the Markush Grouping of SEQ ID Nos. 2, 4, 6 and 8 found in Claim 1 and an

amino acid sequence in SEQ ID Nos. 1, 3, 5 and 7 (Groups 1-4). Accordingly, Applicants believe that the judicial holdings in In re Jones, 74 USPQ 149, 151 (C.C.P.A. 1947) and Ex parte Brouard, 201 USPQ 538, 540 (Pat. Off. Bd. App. 1976) support Applicants' contention that SEQ ID Nos. 1, 3, 5 and 7 and SEQ ID Nos. 2, 4, 6 and 8 should not be restricted in separate inventions. More specifically, in In re Jones the Court held:

> It is evident that in any Markush group, the compounds which are included will differ from each other in certain respects. In determining the propriety of the grouping, these differences must, to some extent, be weighed against the similarities and, as hereinbefore noted, the board pointed out in its decision that "whether a group is proper must be decided in view of the facts of each particular case." The inclusion in Markush groups of compounds which differed widely in some respects, has been permitted. Thus in *Ex parte Clarke and Malm*, 1931 C.D. 6, 11 USPQ 52, the Commissioner of Patents permitted the inclusion of aliphatic, aromatic and aralkyl compounds in a single group. In *Ex parte Kendall*, 56 USPQ 119, the Board of Appeals permitted the grouping of substances which varied "in the character of the connecting chain," and in *Ex parte Dahlen et al.*, 1934 C.D. 9, 42 USPQ 208, the board permitted the grouping of compounds having nuclei and side chains, despite the fact that the allowed claims covered a wide variation in the composition of the side chains.

In the present application, Applicants believe that the Markush grouping of the compounds is proper because the substances grouped have a community of chemical and physical characteristics, which justify their inclusion in a common group, and such inclusion is not repugnant to the principles of scientific classification.

Similarly, in Ex parte Brouard the Court held:

> We appreciate the fact that different fields of search are involved for the six groups listed by the examiner at pages 2 to 4 of his answer. However, the fact that different fields of search are involved does not establish that the Markush group is improper.

Furthermore, in the present application, Applicants submit that the embodiments identified by the Examiner would be found in the same general search and hence would not

require extensive additional searching by the Examiner especially given the computer aided searching presently available to the PTO. It is not readily understood that examining Group A-B in Restriction 1, and the nucleic acid sequence of Groups 1-4 in Restrictions 2 and the amino acid sequence of Groups 5-8 in Restrictions 3 would cause a serious burden on the PTO. On the other hand, the alleged multiple inventions resulting from the restriction requirements would cause Applicants additional expenses and time to prosecute separate patent applications. Consequently, in the interest of efficiency, it is respectfully submitted that the restriction requirements are untenable and ought to be withdrawn.

For the above reasons, reconsideration of the restriction requirements set for the in the outstanding Office Action is respectfully requested.

Applicant has recently appointed new patent counsel to prosecute this application pursuant to a submitted Revocation of Power of Attorney and Change of Correspondence Address. Accordingly, Applicants are requesting the Patent and Trademark Office to note the new correspondence address that is provided below.

5/10/2002
Date of Signature

By: _____
Yi Li
Registration No. 44,211
Agent for Applicant
Telephone: (786) 242-9349

Address correspondence to:

CUSPA Technology Law Associates
11820 SW 107 Ave.
Miami, FL 33176